

RECEIVED  
CENTRAL FAX CENTER

JUL 15 2008

Application No. 10/827,072

REMARKS

Claims 1-7, 9, 10 and 43-50 are pending. Claims 11-20 are canceled without prejudice in view of the restriction requirement. The Examiner was absolutely correct that Applicant elected the species without traverse, and the issue should not have been raised again. New claims 43-50 are added. To advance prosecution, claim 1 has been amended to add the subject matter of claim 8, which is correspondingly cancelled. New claim 43 corresponds with original claim 9 written in independent form. New claims 44-50 correspond with original claims 2-7 and 10. No new matter is introduced.

Applicant thanks the Examiner for the courtesy extended to their undersigned Representative on July 7, 2008. Issues regarding the Kaneda reference were discussed in detail.

Claims 1-10 stand rejected. Applicant respectfully requests reconsideration of the reject based on the following comments in view of the amendment of claim 1.

Rejection Over Kaneda et al.

The Examiner rejected claims 1-3, 5, 7-10 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,638,662 to Kaneda et al. (Kaneda). While Applicants respectfully disagrees with the basis for the Examiner's rejections, Applicant has amended claim 1 to advance prosecution. In view of the amendment, Kaneda clearly does not render Applicant's invention *prima facie* anticipated. Applicant respectfully requests reconsideration of the rejection based on the following comments.

"If the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if that element is 'inherent' in its disclosure. To establish inherency, the intrinsic evidence 'must make it clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or

Application No. 10/827,072

possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." In re Robertson, 49 USPQ2d 1949, 1950, 1951 (Fed. Cir. 1999), citing Continental Can Co. v. Monsanto Co., 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

Amended claim 1 corresponds with original claim 8. The Examiner acknowledged that the uniformity was not expressly disclosed in the Kaneda reference. The particle size distribution is a distinct property of the particles collections. For example, two tennis balls can have the same average ball size as a ping pong ball and a soft ball, but you cannot play tennis with a ping pong ball and a soft ball. Therefore, even if two particle collections are assumed to have similar average particle sizes, this does not imply anything regarding the particle size distribution. Certainly, the teachings of Kaneda do not necessarily lead to the conclusion that a highly uniform particle collection necessarily results from the teachings of Kaneda.

Since Kaneda does not teach or suggest Applicant's presently claimed invention either explicitly or inherently, Applicant respectfully requests withdrawal of the rejection of claims 1-3, 5, 7-10 under 35 U.S.C. § 102(e) as being anticipated by Kaneda. While Applicant does not acquiesce with respect to issues relating specifically to the dependent claims, these issues are not specifically discussed since they are moot in view of the issue raised above.

#### Rejection of Claims 4 and 6

The Examiner rejected claims 4 and 6 as Kaneda as applied above and further in view of U.S. patent 6,534,216B to Narukawa et al. (Narukawa). The Examiner cites Narukawa for teaching substitutions of various metals for a portion of the cobalt in lithium cobalt oxides. However, Narukawa does not make up for the deficiencies of Kaneda with respect to the claimed invention. Applicant respectfully requests reconsideration of the rejection based on the following comments.

RECEIVED  
CENTRAL FAX CENTER  
JUL 15 2008

Application No. 10/827,072

Narukawa does not make up for the deficiencies of Kaneda. In particular, see Fig. 6 of Narukawa. The average particle sizes range from about 7 microns to about 20 microns. The average particle sizes in Narukawa are almost two orders of magnitude larger than Applicant's claimed particle size, which has an upper limit of about 100 nanometers. The combined teachings of Kaneda and Narukawa do not teach or suggest Applicant's claimed invention relating to a particle collection with an average particle size of no more than 100 nm and high uniformity. Thus, the combined teachings of Kaneda and Narukawa clearly do not render Applicant's claimed invention *prima facie* obvious.

Since the combined teachings of Kaneda and Narukawa do not render Applicant's claimed invention *prima facie* obvious, Applicant respectfully requests withdrawal of the rejection of claims 4 and 6 as Kaneda as applied above and further in view of Narukawa. While Applicant does not acquiesce in the Examiner's assertions regarding the specific features of the dependent claims, these are not discussed further here due to the clear deficiencies with respect to the independent claim.

#### CONCLUSIONS

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



Peter S. Dardi, Ph.D.  
Registration No. 39,650

Application No. 10/827,072

Customer No. 62274  
Dardi & Associates, PLLC  
US Bank Plaza, Suite 2000  
220 South 6<sup>th</sup> Street  
Minneapolis, Minnesota 55402  
Telephone: (404) 949-5730